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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JAY McNALLY, PETER TIERNEY,
ROMAN ASADOVSKY, and ALIAKSEI DZIENIS

Appeal 2009-002902
Application 10/797,547
Technology Center 2100

Decided: November 18, 2009

Before JAY P. LUCAS, JOHN A. JEFFERY, and THU A. DANG,
Administrative Patent Judges.

JEFFERY, *Administrative Patent Judge.*

DECISION ON APPEAL

Appellants appeal under 35 U.S.C. § 134(a) from the Examiner’s rejection of claims 1-20. We have jurisdiction under 35 U.S.C. § 6(b). We affirm.

STATEMENT OF THE CASE

Appellants invented a system and method for recovering electronic documents. Stored data is retrieved, analyzed based on metadata and a MD5 hash value, and categorized into categories to identify modifications and deletions of the stored data.¹

Independent claim 1 is reproduced below with the key disputed limitations emphasized:

1. A system for recovering electronic documents archived in a data storage mechanism comprising:

a computer connected with said data storage mechanism, where the computer retrieves a stored data file comprising electronic document data information and further *wherein the retrieved stored data file is analyzed based on file content and file characteristics, and categorized into one or more of a plurality of distinct categories.*

The Examiner relies on the following as evidence of unpatentability:

Vargas US 2004/0204085 A1 Oct. 14, 2004

The Examiner rejected claims 1-20 under 35 U.S.C. § 102(e) as being anticipated by Vargas. Ans. 3-6.²

¹ See generally Spec. 5, 13, 19, and 20; Figs. 2-3.

² Throughout this opinion, we refer to (1) the Appeal Brief filed September 10, 2007 and (2) the Examiner's Answer mailed November 27, 2007.

Regarding representative independent claim 1,³ the Examiner finds that Vargas discloses its recitations, including a computer that can analyze retrieved stored data based on file content and characteristics and categorize the data into categories. Ans. 3 and 7. Appellants argue that Vargas does not disclose: (1) analyzing data for the purpose of categorizing into different categories and (2) analyzing the actual composition of the data because the handles in Vargas are opaque. Br. 11-15.

The issue before us, then, is as follows:

ISSUES

Under § 102, have Appellants shown that the Examiner erred in rejecting claim 1 by finding that Vargas discloses a computer capable of:

- (1) analyzing retrieved data files based on content and characteristics;
and
- (2) categorizing the files into at least one distinct category?

FINDINGS OF FACT

The record supports the following findings of fact (FF) by a preponderance of the evidence:

³ Appellants argue claims 1-20 as a group. *See* Br. 10-15. Merely pointing out what a claim recites (e.g., claims 8 and 17 at Br. 11) is not considered an argument for separate patentability. 37 C.F.R. § 41.37(c)(1)(vii). Accordingly, we select independent claim 1 as representative. *See* 37 C.F.R. § 41.37(c)(1)(vii).

Vargas

1. Vargas discloses a system that includes a computing device 14 (e.g., a personal computer) that includes object stores 34 and 32 and a reference store 750. Program modules, including objects and databases, are located in memory storage devices. ¶¶ 23, 32, and 33; Figs. 1 and 7.

2. Vargas disclose the computing device 14 syncs with a mobile device 12 using synchronization manager 748 that: (a) reads and stores objects and object properties in storage 32 and 34 and (b) reads and writes property names and values to and from objects within a database. An interface, IReplNotify, notifies the synchronization manager 748 when a change or deletion is made to an object in an object store. ¶¶ 57-61; Fig. 7.

3. Vargas' synchronization manager 748 accesses reference store 750 to maintain a mapping between different instances of objects stored in stores 32 and 34. Handles corresponding to objects in stores 32 and 34 are maintained in reference store 750. ¶¶ 64-66.

4. To create a mapping and determine whether objects have been added, deleted, or modified, the sync manager 748 looks for matches in handle lists at step 866 and determine whether objects have been modified at step 870. If a handle on the newly created handle list is not on the previously synchronized handle list, the object has been added. If the handle on the previously synchronized handle list is not on the newly created handle list, the object has been deleted. Using interface, IReplStore:IsItemChanged, the time stamp or version number information associated with the object handle is examined to determine whether a file has changed or been modified. ¶¶ 72-77; Figs. 8A-B.

5. The objects are opaque (i.e., need not be concerned with the actual composition of handle) to the synchronization manager 748 during mapping, although the handles are manipulated and stored by the synchronization manager 748. ¶ 64.

6. Vargas states that the handles are formatted so that the synchronization providers 752 and 754 can perform the specified function of comparing the handles by using an object identifier, an ID number, or a full pathname. This comparison may be problematic for file system information. ¶ 68.

Appellants' Disclosure

7. Appellants disclose the following file parameters can be used to identify modifications and deletions of stored data: original data of creation, last modified date, last accessed date, file size, file name, file path, server path, and MD5 hash value. Spec. 5, 6, and 13.

PRINCIPLES OF LAW

Anticipation is established only when a single prior art reference discloses, expressly or under the principles of inherency, each and every element of a claimed invention as well as disclosing structure which is capable of performing the recited functional limitations. *RCA Corp. v. Appl. Dig. Data Sys., Inc.*, 730 F.2d 1440, 1444 (Fed. Cir. 1984); *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1554 (Fed. Cir. 1983).

“[T]eaching away’ is irrelevant to anticipation.” *Leggett & Platt, Inc. v. VUTEk, Inc.*, 537 F.3d 1349, 1356 (Fed. Cir. 2008) (citation omitted).

ANALYSIS

Based on the record before us, we find no error in the Examiner’s anticipation rejection of representative claim 1. At the outset, we note claim 1 recites a system and not a method. Thus, the recitations to retrieve, analyze, and categorize a stored data file are functional limitations. In order to anticipate claim 1, the prior art’s structure (i.e., Vargas’ computer) needs to be capable of performing these recited functional limitations. *See RCA Corp.*, 730 F.2d at 1444.

Vargas discloses a system that includes a computing device or computer 14 connected with data storage mechanisms (i.e., object stores 32 and 34 and reference store 750). FF 1. The computer 14 syncs with a mobile device 12 using synchronization manager 748 by performing various read, store, and write functions. FF 1-2. For example, one computer interface, IReplNotify, notifies the synchronization manager 748 when a data file (e.g., an object) has been changed or deleted. *Id.* Thus, the computer’s interface categorizes the stored data files into two categories (e.g., change or deleted). In order to determine these categories, Vargas’ computer must analyze the object’s content or characteristics.

Additionally, the synchronization manager 748 of the computer 14 retrieves data files (e.g., lists of handles) in data storage mechanism 750 to maintain a mapping between different instances of objects. FF 3. This mapping is used to determine which data files (e.g., handles in the lists) have been added or deleted from store 32 and 34. FF 4. In order to make this

determination, the synchronization manager 748 compares at step 866 a previously synchronized list of handles to a newly created synchronized list of handles. *Id.* Vargas also discloses the computer performs the step of determining whether an object or data file has been modified a step 870. *Id.* Thus, Vargas' computer categorizes data files (e.g., handles on lists) into at least three distinct categories (e.g., added, deleted, or modified). We therefore disagree with Appellants (Br. 11) that Vargas' synchronization system does not perform the categorization step claim 1 requires.

Appellants argue that the comparisons performed by Vargas do not analyze the files for the purpose of categorizing. Br. 11 and 14. Claim 1 recites "the computer retrieves a stored data file . . . wherein the retrieved stored data file is analyzed . . . and categorized into one or more of a plurality of distinct categories." There is nothing in these recitations that requires the computer to categorize the data file into a distinct category based on the analysis of the file content and characteristics. Thus, this argument is not commensurate with the scope of claim 1.

Appellants also argue that Vargas teaches away from the claimed invention because the handles are opaque to the synchronization manager 748. Br. 12. We are not persuaded. Although "teaching away" arguments are relevant to obviousness rejections, *see KSR Int'l Co., v. Teleflex Inc.*, 550 U.S. 398, 416 (2007), they are irrelevant to anticipation. *Leggett & Platt*, 537 F.3d at 1356. Rather, for anticipation, the relevant inquiry is whether Vargas discloses each and every element of the claimed invention. *See RCA Corp.*, 730 F.2d at 1444.

Based on Vargas' discussion of handles being opaque (FF 5), Appellants further contend that the handles' composition are not analyzed. Br. 12. However, step 866 involves examining each handle or content within lists of handles (e.g., a data file) to determine if an object has been changed or deleted. *See FF 4.* Also, the synchronization process has a computer interface, IReplStore:IsItemChanged, that analyzes each handle's time stamp or version number at step 870 to determine whether the object has changed since it was last written. FF 4. Moreover, a handle may be formatted with an object identifier, an ID number, or a full path name to perform the specified functions, such as IReplStore:IsItemChanged. *See FF 6.* We note that Vargas states that using an object identifier, ID number, or full pathname is problematic *for file system information.* *Id.* However, contrary to Appellants' assertion (Br. 12-13), this does not exclude Vargas from using these identifiers or names to perform Vargas' functions, including step 870, for other types of information. Thus, all of these steps disclose Vargas' computer is capable of analyzing file content and characteristics to determine changes.

Moreover, Appellants have provided no definition for the term "file content." *See FF 7.* Appellants discuss parameters, such as original date of creation, last modified date, last accessed date, file size, file name, file and server path, and MD5 hash, are used to analyze the data. *Id.* Thus, giving this term "file content" its broadest reasonable construction in light of the Specification, "file content" includes the above parameters. *See In re Am. Acad. Of Sci. Tech Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004) (internal citations and quotations omitted). Furthermore, contrary to Appellants' allegations (Br. 12-14), claim 1 does not use the term "metadata," let alone

Appeal 2009-002902
Application 10/797,547

recite that the data file is analyzed based on “metadata.” Thus, while Vargas may not examine the same file content and characteristic data as described by Appellants (FF 7), Vargas nevertheless discloses a computer that analyzes data files based on file content and characteristics as recited in claim 1 given its broadest reasonable interpretation. *See* FF 4 and 6.

For the foregoing reasons, Appellants have not shown the Examiner erred in rejecting claims 1-20 under 35 U.S.C. § 102 based on Vargas.

CONCLUSION

Appellants have not shown that the Examiner erred in rejecting claims 1-20 under § 102.

ORDER

The Examiner’s decision rejecting claims 1-20 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

pgc

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